

REMARKS

This Application has been carefully reviewed in light of the Final Office Action mailed December 15, 2008. At the time of the Office Action, Claims 1-16 were pending in this Application. Claims 1-7 and 10-16 were rejected. Claims 8-9 were previously withdrawn due to an election/restriction requirement. Applicant respectfully requests reconsideration and favorable action in this case.

Rejections under 35 U.S.C. § 102

Claims 1, 7, 10, and 16 stand rejected by the Examiner under 35 U.S.C. §102(b) as being anticipated by International Application Publication No. WO 00/08353 filed by Andreas Voigt et al. ("*Voigt*"). Applicant respectfully traverses and submits that *Voigt* does not teach all of the elements of the claimed embodiment of the invention.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, "the identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co. Ltd.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). Applicant respectfully submits that *Voigt* cannot anticipate the rejected Claims, because *Voigt* does not show all the elements of the present Claims.

The present independent claim 1 includes, in part, the following three distinct elements:

- (a) "a tube spring,"
- (b) "a tube-shaped body, that is connected to the tube spring by joining and is arranged in the area of a second free end of the tube spring," and
- (c) "a means for pretensioning, that is supported by the tube-shaped body and pretensions the piezoelectric actuator."

An example of these three elements is shown in Figure 4 of the present application, which shows:

- (a) a tube spring (32),
- (b) a tube-shaped body (38) that is connected to the tube spring (32) by joining and is arranged in the area of a second free end (35) of the tube spring (32), and
- (c) a means for pretensioning (bolt 39), that is supported by the tube-shaped body (38) and pretensions the piezoelectric actuator (31).

The recited “tube shaped body” is “connected to the tube spring by joining and is arranged in the area of a second free end of the tube spring.” Thus, the “tube-shaped body” and the “tube spring” are clearly *separate elements*. Further, a “means for pretensioning” is “supported by the tube-shaped body.” Thus, the “means for pretensioning” and “tube-shaped body” are also separate elements.

Voigt does not teach these three distinct elements. First, *Voigt* does not teach both (a) “a tube spring” and (b) “a tube-shaped body, that is connected to the tube spring by joining and is arranged in the area of a second free end of the tube spring.” *Voigt* does teach a tubular spring 4. However, *Voigt* does not teach anything that can be equated with “a tube-shaped body, that is connected to the tube spring by joining and is arranged in the area of a second free end of the tube spring.” The Examiner alleges that *Voigt* teaches a “tube shaped body (4)” (Final Office Action, Page 5, “Response to Arguments”). However, the so-called “tube shaped body (4)” of *Voigt* is actually the *tubular spring 4 itself*. Tubular spring 4 is clearly not “connected to [tubular spring 4] by joining and is arranged in the area of a second free end of [tubular spring 4].” To meet this feature of Claim 1, the Examiner must show a tube-shaped body in *Voigt* that is connected to tubular spring 4 by joining, and that is arranged in the area of a second free end of tubular spring 4.” The tubular spring 4 itself clearly cannot meet these requirements.

Second, *Voigt* does not teach (c) “a means for pretensioning, that is supported by the tube-shaped body and pretensions the piezoelectric actuator.” As discussed above, *Voigt* does not teach “a tube-shaped body, that is connected to the tube spring by joining ...” Thus, *Voigt* cannot teach “a means for pretensioning, that is supported by the tube-shaped body.”

Applicant is generally unable to decipher exactly which elements the Examiner is attempting to equate with the elements of Claim 1. If the Examiner maintains his rejection based on *Voigt*, Applicant respectfully requests that the Examiner indicate exactly which elements of *Voigt* (including element reference numbers) the Examiner is equating with each of the following five elements of Claim 1:

- (1) the tube spring,
- (2) the piezoelectric actuator,
- (3) the first cap,
- (4) the tube-shaped body, and
- (5) the means for pretensioning

In view of the foregoing, Applicant submits that Claim 1 is allowable over *Voigt*. In addition, the same arguments apply to independent Claim 10. Hence, Applicant respectfully requests reconsideration and allowance of independent Claims 1 and 10, as well as all claims that depend from Claims 1 and 10.

Rejections under 35 U.S.C. §103

Claims 2-6 and 11-15 were rejected under 35 U.S.C. §103(a) as being unpatentable over *Voigt* in view of U.S. Patent No. 6,326,717 issued to Patrick Mattes ("*Mattes*").

Applicant respectfully submits that dependent Claims 2-6 and 11-15 are allowable at least because they depend from Claims 1 and 10, shown above to be allowable. Applicant reserves the right to make further arguments regarding the Examiner's rejections under 35 U.S.C. §103(a), if necessary, and does not concede that the Examiner's proposed combination is proper.


CONCLUSION

Applicant has made an earnest effort to place this case in condition for allowance in light of the remarks set forth above. Applicant respectfully requests reconsideration of the pending claims.

Applicant believes there are no fees due at this time, however, the Commissioner is hereby authorized to charge any fees necessary or credit any overpayment to Deposit Account No. 50-2148 of Baker Botts L.L.P.

If there are any matters concerning this Application that may be cleared up in a telephone conversation, please contact Applicant's attorney at 512.322.2545.

Respectfully submitted,
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